



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/898,497	07/05/2001	Hirohisa A. Tanaka	05274.00016	8442

758 7590 02/10/2003

FENWICK & WEST LLP
SILICON VALLEY CENTER
801 CALIFORNIA STREET
MOUNTAIN VIEW, CA 94041

EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
----------	--------------

3627

DATE MAILED: 02/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/898,497

Applicant(s)

TANAKA ET AL.

Examiner

James S McClellan

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 July 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4, 9</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: **303** (see page 9, paragraph 35, line 6. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 12, and 23 recite the limitation "the bill rate" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Independent claims 12 and 23 are hybrid claims. Claims 12 and 23 recite limitations towards a product and a process. A single claim which claims both an apparatus and the method steps of using the apparatus is indefinite under 35 U.S.C. § 112, second paragraph. In *Ex parte Lyell*, 17 USPQ2d 1548 (Bd. Pat. App. & Inter, 1990), a claim directed to an automatic transmission workstand and the method steps of using it was held to be ambiguous and properly

Art Unit: 3627

rejected under 35 U.S.C. § 112, second paragraph (see M.P.E.P. 2173.05 (p) II.). For example, claim 12 is directed to a “system” (product) that includes a processor and memory and also includes process steps (a) and (b) related to the product.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 12-33 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 12-33 are rejected under 35 U.S.C. § 101 based on the theory that the claims are directed to neither a “process” or a “machine,” but rather embraces or overlaps two different statutory classes of invention set forth in 35 U.S.C. § 101 which is drafted so as to set forth the statutory classes of invention in the alternative only (see M.P.E.P. 2173.05 (p) II.).

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-2, 6-13, 17-24, and 28-33 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,852,775 (Hirady).

In regards to independent **claim 1**, Hirady discloses a method for determining billing rates of mobile telecommunication connections, comprising the steps of: determining whether a location of a mobile telecommunications unit (MU) is within a predetermined subsidized zone (see column 3, lines 5-7, “server 24 further determines the location of the subscriber ... using subscriber locator 54”); reducing a standard billing rate for a telecommunications connection associated with the MU when the location of the MU is within the predetermined subsidized zone during at least a portion of the telecommunications connection (see column 4, lines 37-47, “adjust the subscriber’s bill accordingly”); wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment (see example in column 3, lines 41-46); **[claim 2]** the billing rate is reduced by a predetermined amount (see column 4, lines 37-47, “adjust the subscriber’s bill accordingly”); **[claim 6]** the information corresponding to the predetermined subsidized zone is stored in a database (see Figure 2, “CELL ID”, 54); **[claim 7]** wherein the predetermined subsidized zone information comprises a time period, and wherein the standard billing rate is reduced when the telecommunications connection occurred at least in part during the time period (it is inherent that all events comprise and occur in a “time period”); **[claim 8]** wherein the subsidized zone is defined by a geographical point and a radius (the zone is defined by the cell size, and each cell has a predefined radius); **[claim 9]** the commercial establishment pays the predetermined amount (see column 4, lines 37-47, via “customer accounts server 20”); **[claim 10]** the predetermined subsidized zone (11) is one of a plurality of subsidized zones (see Figure 1; 11, 11a), each associated with a proximity to a different commercial establishment; **[claim 11]** the standard billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone (11), and the standard billing rate is

Art Unit: 3627

reduced by a second amount when the location of the MU is within a second predetermined subsidized zone (11a, it is inherent that different reductions will exist, since Hirady states that the bill will be justed “accordingly”).

In regards to independent **claim 12**, Hirady discloses a system for determining billing rates of mobile telecommunication connections, comprising: a processor (50); and memory (22, 24) for storing computer readable instructions that, when executed by the processor (50), cause the system to perform the steps described above for claim 1. Since **claims 12, 13, and 17-22** are identical to claims 1, 2, and 6-11, the detailed description above will not be repeated.

In regards to independent **claim 23**, a computer readable medium (22,24) for determining billing rates for mobile telecommunication connections, comprising stored computer readable instructions that, when executed by a processor, cause a computing device to perform perform the steps described above for claim 1. Since **claims 23, 24, and 28-33** are nearly identical to claims 1, 2, and 6-11, the detailed description above will not be repeated. It is noted that claim 33 depends from claim 23, whereas, similar claim 11 depends from claim 10, not claim 1.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 3-5, 14-16, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirady in view U.S. Patent No. 6,411,891 (Jones).

Art Unit: 3627

Hirady discloses all of the limitations as set forth above but fails to explicitly state how the geographic location of the mobile unit is detected.

Jones specifically teaches the use of detecting the geographic location of a mobile telecommunications unit by **[claim 3]** longitude and latitude (see column 17, lines 8-10), **[claim 4]** Global Positioning System (GPS, see column 2, lines 7-11), and **[claim 5]** Universal Transverse Mercator (UTM) numbers (see column 17, lines 8-10).

Since **claims 14-16 and 25-27** are identical to claims 3-5, a detailed description of each limitation will not be repeated.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hirady with the location detection mechanism of GPS, longitude/latitude, or UTM as taught by Jones, because the use of an accurate geographic location mechanism as taught will improve the efficiency and the successfulness of the advertisements, wherein the system will be able to better pinpoint the proximity of the mobile unit to a commercial establishment.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

An article entitled "You can run, but you can't hide" by Hadfield describes the state of the art related to mobile telephone geographic location devices.

Venditti et al. is cited of interest for disclosing a cellular phone zone system.

Art Unit: 3627

Dunn et al. is cited of interest for disclosing a location based method for determining billing charges.

Bolduc et al., Soliman, Welling, Jr. et al., Rouhollahzadeh et al., Richton, and Boyd are cited of interest for disclosing a cell phone system that provides a service by tracking the phone's location.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

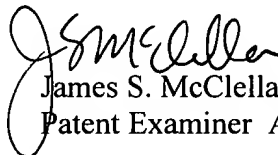
Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Patent Examiner A.U. 3627

jsm
January 24, 2003